

## **REMARKS**

Claims 1-44 are pending.

Claims 1-44 are rejected.

Claims 1, 14, 26, and 44 have been amended.

### **Claim Rejections - 35 U.S.C. § 112**

Claims 1-13 and 29-44 stand rejected under 35 U.S.C. § 112 as indefinite.

#### **Claim 1.**

Claim 1 has been rejected because it is “unclear as what is being performed” in the limitation “performing using the data processing system, wherein the data processing system includes a computer system:”.

Claim 1 has been amended to recite:

performing using a processor of the data processing system;  
developing ...;  
processing ...; and  
determining ... .

Accordingly, the colon at the end of the element “performing using a processor of the data processing system:” and the indented formatting of the “developing”, “processing”, and “determining” elements indicate that each of the “developing”, “processing”, and “determining” elements are performed using the processor of the data processing system. Thus, each of the elements is tied to a particular machine, namely the data processing system and the processor thereof.

#### **Claims 1, 29, and 44 (and claim 14).**

Claims 1, 29, and 44 are rejected because “it is unclear how the determining step is done.” Office Action, p. 3. “Applicant is suggested to amend the claim to recite how the determining step is performed.” *Id.* The determining element states “determining product demand from the evaluations.” NOTE: claim 29 does not include the cited “determining” element. However, claim 14 does. Thus, Applicants assume that the rejection was intended to be for claims 1, 14, and 44.

Claims 1, 14, and 44 have been amended for clarity to recite, “determining product demand from the evaluations of at least the subset of the user session data from the second set of users.”

Further details to the “determining” element are only required if the further details are essential elements as set forth in the specification of the patent application. The MPEP §2163.05 states in part:

A claim that omits an element **which applicant describes as an essential or critical feature of the invention originally disclosed** does not comply with the written description requirement. See *Gentry Gallery*, 134 F.3d at 1480, 45 USPQ2d at 1503; *In re Sus*, 306 F.2d 494, 504, 134 USPQ 301, 309 (CCPA 1962) (“[O]ne skilled in this art would not be taught by the written description of the invention in the specification that any 'aryl or substituted aryl radical' would be suitable for the purposes of the invention but rather that only certain aryl radicals and certain specifically substituted aryl radicals [i.e., aryl azides] would be suitable for such purposes.”) (emphasis in original). Compare *In re Peters*, 723 F.2d 891, 221 USPQ 952 (Fed. Cir. 1983) (In a reissue application, a claim to a display device was broadened by removing the limitations directed to the specific tapered shape of the tips without violating the written description requirement. The shape limitation was considered to be unnecessary since the specification, as filed, did not describe the tapered shape as essential or critical to the operation or patentability of the claim.). **A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record** may also be subject to rejection under 35 U.S.C. 112, para. 1, as not enabling, or under 35 U.S.C. 112, para. 2. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976); *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); and *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968). See also MPEP § 2172.01. (emphasis added).

The present application or other statements of record do not set forth an “essential element” not included in the “determining” element. Accordingly, pursuant to MPEP §2163.05 and the authority cited therein, Applicants respectfully submit that the inclusion of further limitations to the “determining” element is not required by 35 U.S.C. § 112.

#### **Claim 26.**

Claim 26 has been rejected because “it is unclear how the determining step is performed.” Office Action, p. 3. “Applicant is suggested to amend the claim to recite how the determining step is performed.” *Id.*

Applicants respectfully traverse the rejection of claim 26. Claim 26 specifically recites:

collecting data from multiple user sessions from a first set of users with a world wide web (“Web”) site, wherein the user sessions involve selecting a product marketed by the Web site and the collected data includes user navigation data related to selection of a product and Web page data as provided to each of the users in the first set of users;  
developing a product demand master profile set from the collected data;  
collecting a second set of user session data from a second set of users; and  
matching the second set of user session data with the master profile set to determine product demand.

Accordingly, the present application sets for the elements “to determine product demand.” The present application or other statements of record do not set forth an “essential element” not included in claim 26. Accordingly, pursuant to MPEP §2163.05 and the authority cited therein, Applicants respectfully submit that the inclusion of further limitations to determine product demand is not required by 35 U.S.C. § 112.

Accordingly, for at least the foregoing reasons Applicants request withdrawal of the rejection of claims 1-13 and 29-44 and claims dependent directly or indirectly thereon.

### **Claim Rejections - 35 U.S.C. § 101**

Claims 1-28 stand rejected under 35 U.S.C. § 101 as non-statutory. Applicants respectfully traverse the rejection.

Claims 1, 14, and 26 have been rejected for not meeting the machine or transformation test. First, the Supreme Court has struck down the “machine or transformation” test as the sole test for patentability. The Supreme Court stated in *Bilski v. Kappos*, 130 S. Ct. 3218, 561 US \_\_\_, 177 L. Ed. 2d 792 (2010) that:

It is argued that a process patent must either be tied to a particular machine or apparatus or must operate to change articles or materials to a “different state or thing.” We do not hold that no process patent could ever qualify if it did not meet the requirements of our prior precedents.<sup>1</sup>

Nevertheless, claims 1, 14, and 26 are tied to a particular machine and have been amended to further clarify such a relationship.

Claim 1 has been amended to recite:

performing using a processor of the data processing system;

developing ...;

processing ...; and

determining ... .

Claim 14 has been amended to recite:

performing using a processor of the data processing system;

processing ...; and

determining ... .

Claim 26 has been amended to recite:

performing using a processor of the data processing system;

collecting ...;

developing ...

collecting ...; and

matching ... .

Accordingly, the colon at the end of the element “performing using a processor of the data processing system:” in claims 1, 14, and 26 and subsequent indented formatting of the remaining elements indicate that each of the remaining elements are performed using the processor of the data processing system. Thus, each of the remaining elements is tied to a particular machine, namely the data processing system and the processor thereof.

Accordingly, for at least the foregoing reasons, Applicants respectfully request withdrawal of the rejection of claims 1, 14, and 26 and claims dependent directly or indirectly thereon.

## CONCLUSION

Applicant respectfully submits that all pending claims are in condition for allowance. Accordingly, Applicant requests that a Notice of Allowance be issued. Nonetheless, should any issues remain that might be subject to resolution through a telephone interview, the Examiner is requested to telephone the undersigned at 512-338-9100.

### CERTIFICATE OF TRANSMISSION

I hereby certify that on October 4, 2011, this correspondence is being transmitted via the U.S. Patent & Trademark Office's electronic filing system.

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Respectfully submitted,

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